

Docket No.: 60680-1802

Application No.: 10/619,773

REMARKS

Applicant has carefully reviewed the Office Action mailed March 23, 2005. In response to the Office Action, Applicant has amended claims 1, 10, and 12, canceled claims 2 and 11, and added new claims 13-15. By way of this amendment, no new matter has been added. Accordingly, claims 1, 3-10, and 12-15 remain pending in this application. Applicant respectfully requests reconsideration of the present application in view of the above amendment and the following remarks.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 3, 4 and 6-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Jelinek* (4,300,773). Applicant respectfully traverses the rejection.

To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Amended claim 1 positively recites "said one or more coined angles includes a texture to further increase the bonding strength between said base sheet and said elastomeric material." In contrast, Jelinek does not show, teach or suggest a texture applied to an angle. Therefore, Jelinek does not teach every element of independent claim 1.

Dependent claims, 3, 4 and 6-9 are also patentable by being dependent on an allowable base claim. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Amended claim 10 positively recites "applying a texture to an outer surface of the one or more coined angles." In contrast, Jelinek does not show, teach or suggest applying a texture to a coined angle. Therefore, Jelinek does not teach every element of independent claim 10. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

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Claims 1, 3, 4, 6, 7, 9 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by *Fujino* (6,719,300). Applicant respectfully traverses the rejection.

Amended claims 1 and 10 positively recite a texture applied to one or more coined angles. In contrast, *Fujino* does not show, teach or suggest a texture applied to an angle. Therefore, *Fujino* does not teach every element of independent claims 1 and 10. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Jelinek*. Applicant respectfully traverses the rejection.

The comments above with respect to the failure of *Jelinek* to anticipate independent claim 1 are equally applicable here. Specifically, *Jelinek* does not teach applying a texture to a coined angle. Claim 5, depending from claim 1, is patentable for at least the same reasons.

Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jelinek* in view of *Terai* (5,322,299). Applicant respectfully traverses the rejection.

As the limitations of claim 2 (which was dependent upon claim 1) has been incorporated into independent claim 1, and the limitations of claim 11 (which was dependent upon claim 10) has been incorporated into independent claim 10, the following will address this rejection as it pertains to amended claims 1 and 10.

Applicant notes that independent claim 1 positively recites "one or more coined angles formed at said edge of said base sheet," and claim 10 positively recites "forming one or more coined angles at an edge of a base sheet." (emphases added). In contrast, *Jelinek* includes a coined lip 20, 32 that is not an angle as defined by Applicant.

Additionally, there is no suggestion, motivation, or objective reason to combine the cited references. "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453 at 1457 (Fed Cir. 1998). "Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a

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blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' *Id.* quoting *Sensorics, Inc. v. Aerasonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As stated in *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 2d 1241 (Fed. Cir. 1986), prior art references must be read as a whole.

The Examiner has combined the gasket of Jelinek with Terai, stating that "Terai teaches applying a texture 21 at the region the elastomer is to be applied." However, Terai does not teach a texture 21 with an elastomer applied thereto at the edge of a gasket. Jelinek teaches an elastomeric material applied to the edge of a metal gasket that provides a weakened adhesion between the elastomer and the metal. In contrast, the inventor of the present invention was seeking to increase the bonding strength between an elastomeric material and a gasket. (See paragraph [0004]).

A greater amount of material must flow to coin the lip of Jelinek than to coin an angle as claimed in independent claims 1 and 10. As this greater amount of material flows away from what will be the interior corners of the lip of Jelinek, the remaining material between the interior corners is embrittled as the plastic flow of metal decreases ductility. Working metal in compression also induces tensile strain. In contrast, the coined angles (illustrated as 24 in Applicant's FIG. 2) of independent claims 1 and 10 do not require that metal be squeezed to form undesirable interior corners C, but rather are defined by a gradual reduction in thickness toward the edge of the base sheet. Therefore, the inventor has discovered that the angle, as positively recited in claims 1 and 10, offers an increased surface for adhesion of the elastomeric material without creating a weakened area within the connection between the base sheet 16 and the angled portion of base sheet.

Accordingly, one skilled in the art, seeking to produce a gasket with an elastomer bonded to an edge, would recognize this weakness of the edge taught in Jelinek, and would not select Jelinek if combining the teachings from multiple references. Additionally, one skilled in

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the art would not find a 'reasonable expectation of success' in the proposed combination as required by *In re Vaeck*.

Furthermore, one skilled in the art would recognize that the flow of elastomeric material and subsequent adhesion of the elastomeric material onto the interior corners between lip 20 and backing plate 12 of Jelinek would likely exhibit regions of decreased bonding strength due to contamination in the corners from the coining process, or surface tension of the flowing material that prevents a full contact between the elastomeric material and the interior corners before curing. In contrast, the angles of claims 1 and 10 would not exhibit these difficulties of achieving full contact between the elastomeric material and the base sheet 16 since no abrupt interior corner is present, thereby providing a more repeatable process and increased bonding strength. Importantly, Jelinek does not teach or mention increased adhesion between the elastomeric material and the edge of the gasket. Therefore, one skilled in the art, seeking to increase the bonding strength between an elastomeric material and a metal edge, would not select Jelinek, since Jelinek teaches a metal gasket with an edge that is not favorable to adhesion with an elastomeric material.

As evidence that Jelinek is apparently not concerned with adhesion between the elastomeric seal and the edge of the gasket, the installation for the elastomeric seal 24 of Jelinek is illustrated in FIG. 4. being constrained on all sides between housing 38 and end cap 36. Therefore, the elastomeric seal 24 would not appear to require a strong bond with the metal gasket as the bond has negligible tensile forces acting thereon during operation.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Fujino*.
Applicant respectfully traverses the rejection.

The comments above with respect to the failure of *Fujino* to anticipate independent claim 1 are equally applicable here. Claim 5, depending from claim 1, is patentable for at least the same reasons.

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New Claims

New claims 13-15 include limitations that are not contained in the prior art of record. Specifically, Terai does not teach a textured surface that is formed by adding material. (See column 6, lines 36-42).

CONCLUSION

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

It is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 60680-1802 from which the undersigned is authorized to draw.

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